

## REMARKS

Per the non-final Office Action, claims 1-38 are pending and rejected. Herein no claims are amended, no new claims are added, and no claims are canceled.

Entry and favorable consideration of the amendments and remarks presented herewith is earnestly solicited.

### **Double Patenting Rejection**

Claims 1 and 10 stand *provisionally* rejected under the judicially-created doctrine of obvious-type double patenting over claims 1-37 of copending patent application serial number 10/673,934 (Atty. Dkt. P-10500.00).

Applicants note that the rejection is provisional in nature because the allegedly conflicting claims are not in fact patented.

Thus, Applicants reserve the right to submit a terminal disclaimer relative to the copending application in the event that pending claims (as may be amended, canceled, and the like) are indicated as allowable *and still considered* obvious in view of the copending application.

### **Claim Rejections Under 35 U.S.C. §102**

Claims 1-38 are rejected as allegedly anticipated under 35 U.S.C. §102(b) by the '689 published patent application to Connelly et al. (Connelly).

First of all, Applicants respectfully point out that the presently claimed invention relates to **affirmatively blocking an input to (automatic gain controlled) amplifiers used to sense excursions in potential via remotely coupled electrodes**. Connelly is wholly focused upon physical shielding (multiple layers or enclosures of materials) and/or use of optical coupling that is not negatively impacted by electromagnetic insult .

In significant contrast, the presently claimed invention does not "determine a quiet time" for an implantable medical device (IMD), but rather affirmatively

blocks signals – including MRI-induced signals – from reaching sensing circuitry within an IMD housing.

The only mention Connelly makes to this so-called “quiet period” occurs in paragraph 68 which is devoid of enabling details (much less even a generic description of the meaning thereof) and Applicants strongly assert that the Examiner cannot out of thin air attempt to characterize the phrase to be identical to the presently claimed invention. For convenience the recitation of “quiet period” follows (from paragraph 69):

[0069] A still further aspect of the present invention is a method for preventing a tissue implantable device failure during magnetic resonance imaging. The method includes determining a quiet period for a tissue implantable device and generating a magnetic resonance imaging pulse during a quiet period of the tissue implantable device (emphasis added).

And at paragraph 294:

[0294] Alternatively to the electromagnetic insult immune systems described above, a system can avoid failure during magnetic resonance imaging by determining a quiet period for a tissue implantable device and generating a magnetic resonance imaging pulse during a quiet period of the tissue implantable device. Moreover, a system can avoid failure due to an external electromagnetic field source by detecting a phase timing of an external electromagnetic field or external magnetic resonance imaging pulse field and altering operations of the tissue implantable device to avoid interfering with the detected external electromagnetic field or external magnetic resonance imaging pulse field. In these instances the tissue implantable device may be a cardiac assist device (emphasis added).

And at paragraph 381:

[0381] In another embodiment of the present invention, a method prevents a cardiac assist system from failing during magnetic resonance imaging. A magnetic-resonance imaging system determines a quiet period for a cardiac assist system. Upon making this determination, the magnetic-resonance imaging system locks the timing of a magnetic resonance imaging pulse to occur during a quiet period of the cardiac assist system.

That is, Connelly must include *each and every recited claim limitation* in order for the rejection based solely upon Connelly to withstand attack.

A further significant and distinguishing difference between the claimed invention and Connelly can be appreciated from inspection of the claims in view

of Connelly. That is, as emphasized in the excerpt from Connelly, the MRI pulse(s) are generated during a determined quiet period of an IMD. Said another way, the MRI machine is *slaved to the IMD*. In stark contrast, the present invention provides for blanking the sensing circuitry of an IMD in response to generation of radiation from an MRI machine (i.e., the *IMD is slaved to the MRI machine*).

Furthermore, recognizing that Connelly also suggests that one may *alter operations of an IMD* (from the above-cited paragraph 294 - "avoid failure due to an external electromagnetic field source by detecting a phase timing of an external electromagnetic field or external magnetic resonance imaging pulse field and altering operations of the tissue implantable device"), this passage clearly fails to contemplate "blanking" (i.e., blocking) cardiac sensing signals from operative circuitry.

Connelly is completely devoid of any disclosure regarding selectively blocking (i.e., blanking) sensing signals from circuitry and thus cannot fairly support a rejection based on lack of novelty based solely upon Connelly.

Thus, given the completely different approaches to a solution of the problem(s) addressed, it is unreasonable to reject the claimed invention solely based upon Connelly.

Finally, Applicants reserve the right to antedate Connelly thereby rendering Connelly wholly unavailable to the Examiner in the future. Consistent with the foregoing, Applicants do not in any manner imply that Connelly represents prior art vis-à-vis the presently claimed invention.

Accordingly, Applicants respectfully request withdrawal of the rejection based solely upon Connelly.

**Claim Rejections Under 35 U.S.C. §103**

**Claims 6, 15, 26, and 38 are rejected as allegedly anticipated under 35 U.S.C. §103(a) over Connelly in view of the '782 published patent application of McKinnon et al. (McKinnon).**

Applicants hereby incorporate the remarks presented above with respect to Connelly (including, of course, the ability to antedate Connelly) as if fully set

forth herein and add that Connelly appears wholly inadequate to function as a primary reference with any additional references, much less McKinnon.

Thus, Applicants respectfully allege that the Examiner has failed to lodge a *prima facie* obviousness rejection and, without more, the claimed invention is entitled to proceed to timely issuance as U.S. Letters Patent.

In support of the foregoing, Applicants point out that it's been shown that Connelly offers no disclosure, claims or depictions of affirmative blanking of sensor signals for an IMD – and inspection of McKinnon reveals that it is also wholly devoid of any disclosure, description, depiction or claims regarding the claim limitation. Thus, adding McKinnon is a superfluous exercise that fails to advance the stated, and defective, rejection

Applicants conclude that the Examiner has failed to lodge a *prima facie* obviousness rejection inasmuch as the combination of Connelly and McKinnon would not produce the claimed invention. In fact both references are totally lacking in any disclosure regarding the claimed limitations (Connelly fails to even mention “blanking” or “blocking” (or equivalents)).

### **Conclusion**

Applicants respectfully assert that the claims are now in condition for allowance and earnestly solicit the Examiner to issue a Notice of Allowance in due course so the claimed invention may pass to timely issuance as U.S. Letters Patent.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned attorney to attend to these matters.

Respectfully submitted,

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